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10/627,646	07/28/2003	Steven M.H. Wallman	10392-460042	3617

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EXAMINER

FU, HAO

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3696

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07/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/627,646	Applicant(s) WALLMAN, STEVEN M.H.	
	Examiner HAO FU	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Argument

In the remarks, filed on 06/30/2008, the applicant argues that Champion fails to disclose combining orders for each customer with orders from other customers to create a single order for each asset, and Champion further fails to disclose the capability of trading in economically unviable trades, as recited in the amended claims. However, Ray covers such deficiency by disclosing establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization, wherein said aggregating includes combining orders for investments from the customer and the plurality of other customers into a single order for each investment (see column 1, line 59-60, especially “mutual funds which ‘pool’ the assets of a number of shareholders”; one of ordinary skill in the art at the time of invention would understand pooling the assets of a number of shareholders is aggregating investments from different customer's accounts; and when you aggregating a plurality of investments, you are effectively creating a portfolio; the mutual fund management companies does this to reduce work load and increase work efficiency, so that a fund manager can place a single order or establish a common trading strategy for a plurality of investor under management; it appears that the applicant uses this feature for the same reason). The examiner agrees that neither Champion nor Ray teach the capability of trading in the economically unviable trades, such as odd lots, fractional shares or single shares. For this, the examiner provides additional prior arts to fulfill such limitation.

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the content of the passage as taught by the prior art or disclosed by the Examiner.

Claim Rejection – USC 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8, 12, 16, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The examiner does not under the reasoning behind “maintaining in a separate account up to one single share”. Please point out the support in the specification and explain in the claim why such step is needed. The examiner will prosecute these claims with his best judgment.

Claim Rejection – USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-5, 6, 10, 14, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.: 5,126,936 to Champion et al., in view of US Patent No.: 6,018,722 to Ray et al., and further in view of Palm Beach Post (Pam Beach Post, Direct-buy stocks cut out middle man, Mar 9, 1998, pg. 17).

As per claim 1, Champion teaches a method for managing an investment account for a customer associated with a sponsoring organization comprising the steps of (see column 3, line 8-12):

interacting with the customer over a computer network (see Fig 2, “modem” and “computer” suggest that customers can be reached over a computer network) to create a portfolio of investments that satisfy a plurality of restrictions on investment activity of the customer while meeting pre-defined investment needs of the customer (see column 4, line 6-21, and line 31-46, also see column 5, line 40-52);

transmitting a portfolio of desired investments over the computer network for execution (see column 5, line-8-15, and line 47-57).

Examiner notes however, Champion does not teach establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization, wherein said aggregating includes combining orders for investments from the customer and the plurality of other customers into a single order for each investment, including combining at least one economically unviable order for an investment.

Ray teaches establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization, wherein said aggregating includes combining orders for investments from the customer and the plurality of other customers into a single order for each investment (see column 1, line 59-60, especially “mutual funds which ‘pool’ the assets of a number of shareholders”; one of ordinary skill in the art at the time of invention would understand pooling the assets of a number of shareholders is aggregating investments from different customer’s accounts; and when you aggregating a plurality of investments, you are effectively creating a portfolio; the mutual fund management companies does this to reduce work load and increase work efficiency, so that a fund manager can place a single order or establish a common trading strategy for a plurality of investor under management; it appears that the applicant uses this feature for the same reason).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization for the benefit of reducing work load and increasing efficiency.

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Palm Beach Post teaches combining at least one economically unviable order for an investment, such as buying a single share of an investment vehicle (see page 1, prior art teaches executing a single share trade, see especially, "For DRIP programs, the National Association of Investors Corp. (NAIC), which helps people involved in investment clubs, allows its members to buy a single share through them"; prior art also disclose that a single share trade is not normally handled by brokers, because it is economically unviable, and a single share trade is defined as economically unviable by the applicant).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include combining at least one economically unviable order for an investment for the benefit of molding an investment plan to an investor's own financial means and goals, as taught in Newberry (Jon Newberry, Bye bye broker, ABA Journal, Mar 1998, Vol. 84 pg. 90, 1pgs).

As per claim 2, Champion teaches a method for managing a plurality of investment accounts (see column 4, line 46-51, it is implied that there is a plurality of accounts), each of which is associated with a third party user (see column 4, line 66-67, it is implied that each account is associated with a third party user), comprising the steps of:

receiving data from the user regarding the plurality of investment accounts, the data defining the amount and types of investments to be included in each investment account (see column 4, line 56-65);

aggregating the plurality of investment accounts into a single portfolio of investments for the user (see column 4, line 46-51, aggregating a total level of risk for all customer accounts is analogous to aggregating plurality of accounts into a single portfolio then performing risk analysis);

analyzing the single portfolio to determine a risk/reward characteristic of the single portfolio (see column 4, line 46-51).

Examiner notes however, Champion does not teach establishing an aggregate portfolio of investments from the third party user and from a plurality of other users, wherein said establishing an aggregate portfolio includes combining orders for investments from the third party user and the plurality of other users into a single order for each investment, including combining at least one economically unviable order for an investment.

Ray teaches establishing an aggregate portfolio of investments from the third party user and from a plurality of other users, wherein said establishing an aggregate portfolio includes combining orders for investments from the third party user and the plurality of other users into a single order for each investment (see column 1, line 59-60, especially "mutual funds which 'pool' the assets of a number of shareholders"; one of ordinary skill in the art at the time of invention would understand pooling the assets of a

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number of shareholders is aggregating investments from different customer's accounts; and when you aggregating a plurality of investments, you are effectively creating a portfolio; the mutual fund management companies does this to reduce work load and increase work efficiency, so that a fund manager can place a single order or establish a common trading strategy for a plurality of investor under management; it appears that the applicant uses this feature for the same reason).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include establishing an aggregate portfolio of investments from the third party user and from a plurality of other users for the benefit of reducing work load and increasing efficiency.

Palm Beach Post teaches combining at least one economically unviable order for an investment, such as buying a single share of an investment vehicle (see page 1, prior art teaches executing a single share trade, see especially, "For DRIP programs, the National Association of Investors Corp. (NAIC), which helps people involved in investment clubs, allows its members to buy a single share through them"; prior art also disclose that a single share trade is not normally handled by brokers, because it is economically unviable, and a single share trade is defined as economically unviable by the applicant).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include combining at least one economically unviable order for an investment for the benefit of molding an investment plan to an investor's own financial means and goals, as taught in Newberry (Jon Newberry, Bye bye broker, ABA Journal, Mar 1998, Vol. 84 pg. 90, 1pgs).

As per claim 3, Champion teaches a method for creating a plurality of separate investment accounts while managing the plurality of separate investment accounts as a single investment portfolio (see column 3, line 30-40), comprising the steps of:

establishing a separate file for each of the plurality of separate investment accounts (see column 3, line 30-34, and column 4, line 6-10);

analyzing the plurality of separate investment accounts as if the plurality of separate investment accounts were a single investment portfolio, the analysis including at least one of: a risk level analysis (see column 4, line 46-51), a diversification analysis (see Fig 1), a concentration analysis and a sector exposure analysis (see column 3, line 46-47) for the single portfolio.

Examiner notes however, Champion does not teach establishing an aggregate portfolio of investments from the single investment portfolio and from a plurality of other customers, wherein said establishing an aggregate portfolio includes combining orders for investments from the investment accounts into a single order for each investment, including combining at least one economically unviable order for an investment.

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Ray teaches establishing an aggregate portfolio of investments from the single investment portfolio and from a plurality of other customers, wherein said establishing an aggregate portfolio includes combining orders for investments from the investment accounts into a single order for each investment (see column 1, line 59-60, especially "mutual funds which 'pool' the assets of a number of shareholders"; one of ordinary skill in the art at the time of invention would understand pooling the assets of a number of shareholders is aggregating investments from different customer's accounts; and when you aggregating a plurality of investments, you are effectively creating a portfolio; the mutual fund management companies does this to reduce work load and increase work efficiency, so that a fund manager can place a single order or establish a common trading strategy for a plurality of investor under management; it appears that the applicant uses this feature for the same reason).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include establishing an aggregate portfolio of investments from the single investment portfolio and from a plurality of other customers for the benefit of reducing work load and increasing efficiency.

Palm Beach Post teaches combining at least one economically unviable order for an investment, such as buying a single share of an investment vehicle (see page 1, prior art teaches executing a single share trade, see especially, "For DRIP programs, the National Association of Investors Corp. (NAIC), which helps people involved in investment clubs, allows its members to buy a single share through them"; prior art also disclose that a single share trade is not normally handled by brokers, because it is economically unviable, and a single share trade is defined as economically unviable by the applicant).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include combining at least one economically unviable order for an investment for the benefit of molding an investment plan to an investor's own financial means and goals, as taught in Newberry (Jon Newberry, Bye bye broker, ABA Journal, Mar 1998, Vol. 84 pg. 90, 1pgs).

As per claim 4, Champion teaches a method for managing an investment account of a plurality of customers associated with a sponsoring organization (see column 3, line 8-12, and line 30-34), comprising the steps of:

establishing a plurality of restrictions on the investment activity of the plurality of customers associated with the sponsoring organization (see column 4, line 6-21, and line 31-46);

interacting with a first customer over a computer network (see Fig 2, "modem" and "computer" suggest that customers can be reached over a computer network) to identify a portfolio of investments that satisfy the plurality of defined restrictions while meeting customer defined investment needs of the first customer (see column 4, line 6-

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21, and line 31-46, also see column 5, line 40-52);

transmitting a plurality of trade requests over a computer network identifying a plurality of investments in the aggregate portfolio (see column 5, line-8-15, and line 47-57).

Examiner notes however, Champion does not teach establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers, wherein said establishing an aggregate portfolio includes combining orders for investments from the first customer and the plurality of other customers into a single order for each investment, including combining at least one economically unviable order for an investment.

Ray teaches establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers, wherein said establishing an aggregate portfolio includes combining orders for investments from the first customer and the plurality of other customers into a single order for each investment (see column 1, line 59-60, especially "mutual funds which 'pool' the assets of a number of shareholders"; one of ordinary skill in the art at the time of invention would understand pooling the assets of a number of shareholders is aggregating investments from different customer's accounts; and when you aggregating a plurality of investments, you are effectively creating a portfolio; the mutual fund management companies does this to reduce work load and increase work efficiency, so that a fund manager can place a single order or establish a common trading strategy for a plurality of investor under management; it appears that the applicant uses this feature for the same reason).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers for the benefit of reducing work load and increasing efficiency.

Palm Beach Post teaches combining at least one economically unviable order for an investment, such as buying a single share of an investment vehicle (see page 1, prior art teaches executing a single share trade, see especially, "For DRIP programs, the National Association of Investors Corp. (NAIC), which helps people involved in investment clubs, allows its members to buy a single share through them"; prior art also disclose that a single share trade is not normally handled by brokers, because it is economically unviable, and a single share trade is defined as economically unviable by the applicant).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include combining at least one economically unviable order for an investment for the benefit of molding an investment plan to an investor's own financial means and goals, as taught in Newberry (Jon Newberry, Bye bye broker, ABA Journal, Mar 1998, Vol. 84 pg. 90, 1pgs).

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As per claim 5, Champion teaches a method for creating a plurality of separate investment accounts (see column 3, line 30-34, and column 4, line 6-10) while managing the plurality of separate investment accounts as a single portfolio (see column 4, line 46-51, aggregating a total level of risk for all customer accounts is managing the plurality of separate investment accounts as a single portfolio), comprising the steps of:

calculating a risk/reward analysis for each of the plurality of separate investment accounts (see column 3, line 30-40);

receiving, for each of the plurality of separate investment accounts, from a customer an indication of the customer's preferences regarding said risk/reward analysis (see column 5, line 47-61, the invention in prior art first gives user recommendation of buying/selling asset, then it receives a confirmation of user's trade execution; the confirmation of trade execution is an indication of the customer's preference regarding the risk/reward analysis).

Examiner notes however, Champion does not teach establishing an aggregate portfolio of investments from the accounts and from a plurality of other customers, wherein said establishing an aggregate portfolio includes combining orders for investments from the plurality of investment accounts into a single order for each investment, including combining at least one economically unviable order for an investment.

Ray teaches establishing an aggregate portfolio of investments from the accounts and from a plurality of other customers, wherein said establishing an aggregate portfolio includes combining orders for investments from the plurality of investment accounts into a single order for each investment (see column 1, line 59-60, especially "mutual funds which 'pool' the assets of a number of shareholders"; one of ordinary skill in the art at the time of invention would understand pooling the assets of a number of shareholders is aggregating investments from different customer's accounts; and when you aggregating a plurality of investments, you are effectively creating a portfolio; the mutual fund management companies does this to reduce work load and increase work efficiency, so that a fund manager can place a single order or establish a common trading strategy for a plurality of investor under management; it appears that the applicant uses this feature for the same reason).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include establishing an aggregate portfolio of investments from the accounts and from a plurality of other customers for the benefit of reducing work load and increasing efficiency.

Palm Beach Post teaches combining at least one economically unviable order for an investment, such as buying a single share of an investment vehicle (see page 1, prior art teaches executing a single share trade, see especially, "For DRIP programs, the National Association of Investors Corp. (NAIC), which helps people involved in

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investment clubs, allows its members to buy a single share through them"; prior art also disclose that a single share trade is not normally handled by brokers, because it is economically unviable, and a single share trade is defined as economically unviable by the applicant).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include combining at least one economically unviable order for an investment for the benefit of molding an investment plan to an investor's own financial means and goals, as taught in Newberry (Jon Newberry, Bye bye broker, ABA Journal, Mar 1998, Vol. 84 pg. 90, 1pgs).

As per claim 6, 10, 14, 18, Champion does not teach wherein said economically unviable trading order includes at least one trading order for a single share of one investment.

Palm Beach Post teaches combining at least one economically unviable order for an investment, such as buying a single share of an investment vehicle (see page 1, prior art teaches executing a single share trade, see especially, "For DRIP programs, the National Association of Investors Corp. (NAIC), which helps people involved in investment clubs, allows its members to buy a single share through them").

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include wherein said economically unviable trading order includes at least one trading order for a single share of one investment for the benefit of molding an investment plan to an investor's own financial means and goals, as taught in Newberry (Jon Newberry, Bye bye broker, ABA Journal, Mar 1998, Vol. 84 pg. 90, 1pgs).

Claim 7, 11, 15, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.: 5,126,936 to Champion et al., in view of US Patent No.: 6,018,722 to Ray et al., and further in view of Palm Beach Post (Pam Beach Post, Direct-buy stocks cut out middle man, Mar 9, 1998, pg. 17), and further in view of Newberry (Jon Newberry, Bye bye broker, ABA Journal, Mar 1998, Vol. 84 pg. 90, 1pgs).

As per claim 7, 11, 15, 19, Champion does not teach wherein said economically unviable trading order includes at least one trading order for a fractional share of one investment.

Newberry teaches allowing individuals to buy either full or fractional shares (see page 1). Therefore, Newberry teaches wherein said economically unviable trading order includes at least one trading order for a fractional share of one investment.

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It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include wherein said economically unviable trading order includes at least one trading order for a fractional share of one investment for the benefit of molding an investment plan to an investor's own financial means and goals.

As per claim 8, 12, 16, 20, Champion teaches maintaining in a separate account (see column 3, line 30-47). Examiner notes however Champion does not teach performing single share trade or fractional share trade, and thus fails to teach maintaining in a separate account up to one single share of each investment in which there is at least one trading order for a fractional share of said each investment.

Palm Beach Post teaches allowing single share of an investment (see page 1). Newberry teaches allowing individuals to buy either full or fractional shares (see page 1). Therefore, if combine all three references, each individual account owned by an individual, who is a member of an investment club or organization, could have one single share of each investment in which there is at least one trading order for a fractional share of said each investment.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include maintaining in a separate account up to one single share of each investment in which there is at least one trading order for a fractional share of said each investment for the benefit of molding an investment plan to an investor's own financial means and goals.

Claim 9, 13, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.: 5,126,936 to Champion et al., in view of US Patent No.: 6,018,722 to Ray et al., and further in view of Palm Beach Post (Pam Beach Post, Direct-buy stocks cut out middle man, Mar 9, 1998, pg. 17), and further in view of Wall Street Journal (Wall Street Journal, Frankfurt to launch trading system, Oct 7, 1997. pg.14).

As per claim 9, 13, 17, Champion does not teach wherein said economically unviable trading order includes at least one trading order for an odd lot of shares of one investment.

Wall Street Journal teaches accepting smaller private odd-lot orders (see page 1, 9th paragraph under Full Text). Therefore, Wall Street Journal teaches wherein said economically unviable trading order includes at least one trading order for an odd lot of shares of one investment.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include wherein said economically unviable trading order includes at least one trading order for an odd lot of shares of one investment for

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the benefit of molding an investment plan to an investor's own financial means and goals.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO FU whose telephone number is (571)270-3441.

The examiner can normally be reached on Mon-Fri/Mon-Thurs 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THOMAS A DIXON/
Supervisory Patent Examiner, Art Unit 3696

Hao Fu
Examiner
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JULY-08

/Hao Fu/
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